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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,645	04/09/2001	Kulbir S. Sandhu	M-9710 US	7663

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EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,645

Applicant(s)

SANDHU ET AL.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet- 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is incomplete. Additionally, since it is incomplete, it is not clear whether or not the subject matter is directed to a separate invention.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3, 6-11, 14, 15, 17, 19-21, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuma in view of Kimoto et al.

The rejection is set forth in the previous Office Action

Argues that the prior art of Sakuma and Kimoto fails to disclose the limitation of claim 1 of "receiving a request from said first mobile unit specifying a condition based on the current location . . . or a future location of said first mobile unit . . . transmitting a data package to said first mobile unit in response to said request . . . upon satisfaction of said condition . . . wherein said data package comprises said current location of said second mobile unit." Subsequently, the applicants argue that claims 14, 20, and 23 as well as their respective dependent claims are likewise allowable for respective limitations. Note, however, only claim 20 provides such limitations. Thus, claim 14 and 23 do not provide such limitations and thus, the features for which the applicants argue are not found therein and therefore are not allowable for such reasons. Moreover, in Sakuma, the location request includes a specification of a condition for map data,

see col. 4, wherein the mobile user receives a map data response message conveying the map data which is used to display the map together with the locations of the own terminal as well as the called terminal. Thus, the claim language for which the applicants argue is met by the prior art and the further claims which do not include such limitations are met even more so since the search criterion in the request is met by the request for map data associated with the location of the calling terminal as well as the location of the called terminal.

Applicants argue that the prior art fails to teach claim 3 and its provision for personal information about the user or an announcement. This is not persuasive, particularly in light of the fact that the first caller PS1 includes personal information/announcement such as the telephone number/identification number thereof in its request to locate the second caller. Moreover, "an announcement" is met by any transmission, including transmission of ID or location.

Applicants argument that Sakuma teaches away from the combination is not convincing, particularly in light of the fact that the supposed portion is merely descriptive of what was known in the art prior to Sakuma and for which Sakuma attempts to better.

5. Claims 4, 5, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuma in view of Kimoto et al and Schilit et al.

The rejection is set forth in the previous Office Action.

Applicants argue that Schilit does not cure the deficiencies of the Sakuma and/or Kimoto and is allowable in view of the dependencies to the allegedly allowable independent claims. As set forth above, the prior art is deemed to teach/suggest the claimed limitations and since the

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applicants rely on the subject matter of the independent claims, the dependent claims stand or fall therewith.

6. Claims 1-11, 13-15, 17 and 19-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adachi in view of Holland.

The rejection is set forth in the previous Office Action.

Applicants argue the same respective claim language with respect to the rejection over Adachi and Holland. However, the arguments are not persuasive since the condition that is specified is met by the group ID number wherein the request includes the group ID number and the data package transmitted includes the locations of the users associated with the group ID numbers. Thus, the applicants' arguments are not convincing. Furthermore, the combination with Holland suggests a database that includes information about each user, see col. 3 for example.

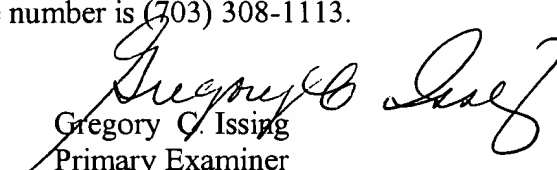
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci